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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Joel G. Hassell

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EXAMINER

PARRA, OMAR S

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2421

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/734,505	Applicant(s) HASSELL ET AL.	
	Examiner OMAR PARRA	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 106-145 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 106-145 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>08/26/2010, 08/03/210, 06/14/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/14/2010 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 106-145 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 136-145 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant's specification, at least at page 32 line 32-col. 33 line 9, state that:

"The global media library may be maintained automatically by the program guide. For example, the program guide may store or update directory entry information according to the current viewer preferences (described below) in a central storage area

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(e.g., random access memory (RAM) or a central hard disk drive) each time directory information is stored or updated on a removable storage medium. The program-guide may also store unique identifiers identifying the removable storage medium on which programs are stored (e.g., volume names or media numbers)".

The cited paragraph discloses that "For example,...information can be stored or updated at (e.g. random access memory RAM or central hard disk drive....or on removable storage medium. In the broadest reasonable interpretation, claims 136-145 can include a signal as one of the other not mentioned examples given by applicant's specification. The examiner, in the broadest reasonable interpretation of the claim language, construes claim-136's "*computer readable medium for providing a user of an interactive television program guide with access to broadcast television programs and recorded programs stored on a digital storage device in the user's equipment, comprising machine program logic recorded thereon*" to a signal carrying processor-executable instructions, and therefore, it is a non-statutory subject matter.

The examiner suggests to correct claims 136-145 to recite "non-transitory computer readable medium", "computer readable device" or some other phrase that explicitly excludes a signal as the computer readable medium.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **106-114, 116-124, 126-134 and 136-144** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (hereinafter 'Schein', Pub. No. 2003/0196201, of record) in view of Hailey et al. (hereinafter 'Hailey', Patent No. 7,533,400).

Regarding claims 106, 116, 126 and 136, Schein teaches a system (with respective method and computer readable medium) for an interactive television program guide that provides a user with access to broadcast television programs and recorded programs stored on a digital storage device in the user's equipment, the system comprising:

a digital storage device for recording programs **([0039])**; and
a display device **(80, Fig. 3)** for providing to the user a list of selectable options **(Pull down menu 114, Fig. 6B; [0045]; [0051] or as incorporated by reference, Young [Patent No. 5,353,121, of record], hereinafter 'Young': Top 4 Selectable cells on Fig. 4, col. 16 lines 15-31)** comprising a first selectable option **(Young: On Grid Prog", Fig. 4)** and a second selectable option **(Young: 2. "Recorded Programs")**, wherein the first selectable option is provided for allowing the user to access a list of selectable program listings having at least one selectable program listing for a broadcast television program and at least one selectable program listing for a recorded program stored on the digital storage device **(Young: the "On Grid Prog", Fig. 4 takes the user to the program listing on a grid, which includes at least one broadcast program and at least one recorded program, col. 8 lines 8-35), and**

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wherein the second selectable option is provided for allowing the user to access a list of recorded programs stored on the digital storage device **(the “Recorded Programs” options on Fig. 4 takes the user to a listing of recorded programs, Fig. 13, from which playback is allowed; col. 14 lines 11-46);** and

control circuitry **(228, Fig. 22A, which controls the storage device)** for:

receiving a user selection of a recorded program from the list of selectable program listings **(the user can select a recorded program from the grid option by highlighting it, col. 8 lines 19-48).**

On the other hand, although Schein and Young, (as incorporated by reference in its entirety) teach that a recorded program can be played from the storage device in response to receiving selection from a list of recorded programs (col. 13 line 44-col. 14 line 46; col. 19 lines 53-61), Schein and Young do not explicitly teach playing a recorded program in response to receiving the user selection of the recorded program from the list of selectable program listings.

However, in an analogous art, Hailey teaches a composite guide that includes all the resources available to the user or viewer (Fig. 2). Hailey's guide contains all broadcast channels along with the stored content on multiple devices and services such as emails, phone, fax, DVDs, etc (Fig. 2; col. 7 line 38-col. 8 line 25). All this content is part of a grid-like guide (Fig. 2; col. 7 line 38-col. 8 line 25). Additionally, Hailey teaches that the stored content included in the guide can be played back from the guide itself (Fig. 2; col. 7 line 38-col. 8 line 25, especially col. 8 lines 3-9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Schein's (and referenced Young's) with Hailey's feature of playing back stored from the program grid for the benefit of not having the user to go to the list of recorded programs every time he/she needs to watch a recorded program and to go back to the grid schedule if he/she decides not to watch the recorded program.

Regarding claims 108, 118, 128 and 138, Schein (Young) and Hailey teach a system (with respective method and computer readable medium) further comprising allowing the user to interact with the stored associated program data during playback of the recorded program **(Young: The user is able to interact with the stored associated data: searching the data by moving the cursor on the titles of the recorded programs for playback, col. 11 lines 47-65, or when searching through playback, or high speed repositioning, the title info will be displayed to the user, col. 13 line 64-col. 14 line 46).**

Regarding claims 109, 119, 129 and 139, Schein (Young) and Hailey teach a system (with respective method and computer readable medium) wherein the associated program data includes user added information **(Young: Updating or adding of related data can be performed by the user, col. 12 lines 31-35).**

Regarding claims 110, 120, 130 and 140, Schein (Young) and Hailey teach a system (with respective method and computer readable medium) further comprising:

providing a selectable option that allows the user to access a list of programs scheduled to be recorded (**Young: Pending Recordings option, Fig. 4**).

Regarding claims 111, 121, 131 and 141, Schein (Young) and Hailey teach a system (with respective method and computer readable medium) further comprising:

providing the user with an opportunity to select a program listing for a program scheduled to be recorded (**Young: To-be-recorded program 26 in Fig. 6, can be selected from the schedule that also includes to-be-recorded programs**); and

displaying an information screen for the selected program in response to the user selecting the program scheduled to be recorded (**Young: 52, Fig. 6 is displayed whenever a cell on the program schedule, col. 9 lines 9-50**).

Regarding claims 112, 122, 132 and 142, Schein (Young) and Hailey teach a system (with respective method and computer readable medium) further comprising:

providing a selectable option that allows the user to transfer the stored program to a removable storage device (**Although the recording media could be removable, it is well known in the art of recording media the ability of copying or dubbing content to a removable media**).

Regarding claims 113, 123, 133 and 143, Schein (Young) and Hailey teach a system (with respective method and computer readable medium) further comprising:

providing a selectable option that allows the user to access a set-up screen
(Clicking on a program will open a set-up screen, InfoMenu 130, Fig. 8B, [0053]);
and

providing the user with an opportunity to define one or more recording options
using the set-up screen **(By selecting 'Record this program' option from the set-up
screen, user can define recording options, Fig. 8C, [0053]).**

Regarding claims 114, 124, 134 and 144, Schein (Young) and Hailey teach a
system (with respective method and computer readable medium) further comprising:

providing the user with an opportunity to define one or more playback options
using the set-up screen **('Restrict access to this program' option, Fig. 8B).**

6. Claims **115, 125, 135 and 145** are rejected under 35 U.S.C. 103(a) as being
unpatentable over Schein et al. (hereinafter 'Schein', Pub. No. 2003/0196201, of record)
in view of Hailey et al. (hereinafter 'Hailey', Patent No. 7,533,400) in further view of
Goldschmidt Iki et al. (hereinafter 'Goldschmidt', Patent No. 6,226,444, of record).

Regarding claims 115, 125, 135 and 145, Schein (Young) and Hailey teach all
the limitations of the claims they depend on. On the other hand, Schein does not
explicitly teach a system further comprising:

determining whether the digitally stored programs include advertisements; and
providing the user with an opportunity to play back the recorded program without
displaying the advertisements.

However, in an analogous art, Goldschmidt teaches an (EPG 500, Fig. 5) from which setting a recording without commercials is possible (620, Fig. 6) and consequently, the playback of said program without commercials.

Therefore, it would have been obvious to an ordinary skilled in the art at the time of the invention to have modified Schein (Young) and Hailey's invention with the no-commercials recording feature as taught by Goldschmidt for the benefit of having a continuous playback of a program without the interruption of commercials or for saving storage space of unnecessary material to the viewer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMAR PARRA whose telephone number is (571)270-1449. The examiner can normally be reached on 9-6 PM (M-F, every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

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